

### **REMARKS**

This Amendment is responsive to the Final Office Action dated April 29, 2010. Applicant has amended claims 1, 3-10, and 22, and added new claims 32 and 33. Claims 2, 11-21, 23, 25, and 28-31 were previously cancelled. No new matter is added by way of the amendments, and support for the amendments can be found throughout the originally-filed disclosure. For example, with respect to the amendments to claims 1, 3-10, and 22, support can be found at least in paragraphs [0025] and [0028]; with respect to new claim 32, support can be found at least in paragraph [0034]; and with respect to new claim 33, support can be found at least in paragraph [0035]. Claims 1, 3-10, 22, 24, 26, 27, 32, and 33 will be pending upon entry of this Amendment.

### **Claim Rejection Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claim(s) 1, 4-7, 9-10, 22, 24, and 26-27 under 35 U.S.C. § 102(e) as being anticipated by Elaz et al. (U.S. Patent Publication No. 2005/0124866, hereinafter “Elaz”). In addition, the Examiner rejected claims 1, 5, and 7-9 under 35 U.S.C. § 102(b) as being anticipated by Gehab et al. (US 5,685,314, hereinafter “Gehab”). Applicant respectfully traverses the rejections, particularly to the extent such rejections may be considered applicable to the claims as amended.

#### ***Rejections in view of Elaz***

As a preliminary matter, Applicant notes that the portion of Elaz cited in the Office Action is disqualified from being used in a rejection under 35 U.S.C. § 102(e) based on the relative priority dates of the pending claims and the Elaz reference. The claims of the present application claim priority to International PCT Application No. US2004/012421 filed on April 22, 2004, as well as to U.S. Provisional Application Serial No. 60/530,151, filed on December 17, 2003. Review of these priority documents illustrates that U.S. Provisional Application Serial No. 60/530,151 provides adequate support for the pending claims under 35 U.S.C. § 112, thus entitling the claims to a priority date dating back at least to December 17, 2003. Support for the pending claims can be found throughout the originally-filed provisional application including, for example, at paragraphs [0016]–[0020] and [0196]–[0203].

The Elaz reference has an application filing date of October 28, 2004, and claims priority to U.S. Provisional Application Serial No. 60/519,300, filed on November 12, 2003. However, the portions of Elaz cited in the Office Action are not included in the Elaz provisional application. In particular, the provisional application by Elaz provides no disclosure regarding battery power, external power, a power bus, a power connection, or other charging functions associated with power, all of which are features the Office Action cited Elaz as purportedly disclosing. Therefore, while the priority date of U.S. Provisional Application Serial No. 60/519,300 by Elaz facially predates the priority date of Applicant's U.S. Provisional Application Serial No. 60/530,151, Applicant's provisional application is supporting while Elaz's provisional application is not supporting.

According to MPEP § 706.02(f)(1), "the 35 U.S.C. § 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph." Applying this standard to the rejection raised in the Office Action, the earliest effective U.S. filing date for the Elaz reference is October 28, 2004, because the provisional application of Elaz does not properly support the subject matter used to make the rejection. On the other hand, Applicant's claims are entitled to priority dating back at least to November 12, 2003, thereby antedating the Elaz reference.

In view of the inapplicability of Elaz, Applicant submits that the rejections based on Elaz are unwarranted, and reconsideration and withdrawal of the rejections are respectfully requested.

Moreover, even assuming for the sake of argument that Elaz could be used in a rejection under 35 U.S.C. § 102(e), Elaz fails to disclose or suggest the features defined by the claims as amended. For example, Elaz fails to disclose or suggest the features of independent claims 1, 7, and 22. Independent claims 1, 7, and 22 are each directed toward a modular external defibrillator system that includes, among other elements, a base containing a defibrillator, and a patient monitoring pod. As amended, the independent claims specify that the base containing the defibrillator is a portable base. Nothing in Elaz discloses or suggests at least these features of the amended independent claims.

Elaz is directed toward a processing device and display system for supporting a plurality of different modules that provide different healthcare functions to a patient.<sup>1</sup> Elaz describes that the plurality of different modules are plugged into and removed from a central unit 300, which Elaz describes as a housing that comprises a central processor 200 and a display generator 300.<sup>2</sup> Elaz also describes that the central unit 300 includes a communications power hub 235 for distributing power both to the central unit 300 and to the different modules.<sup>3</sup>

Contrary to the requirements of the independent claims, however, Elaz does not disclose or suggest a base containing a defibrillator. In the rejection of the previously presented claims, the Office Action asserted that Elaz discloses a centralized base station (e.g., central unit 300) that has the ability to dock a treatment and monitoring module thereon.<sup>4</sup> The Office Action further asserted that one type of module that may be docked in Elaz is a defibrillator.<sup>5</sup> On this basis, the Office Action concluded the Elaz discloses a base containing a defibrillator.

Yet a base to which a defibrillator can be docked is different than a base containing a defibrillator. A base and a defibrillator that can be docked or undocked are two separate components. Indeed, Elaz describes separate modules that may be connected or detached from a central unit via a release mechanism.<sup>6</sup> On the other hand, the independent claims require a base containing a defibrillator. Accordingly, because the base and defibrillator of Elaz are different units, the base and defibrillator of Elaz cannot reasonably be characterized as a base containing a defibrillator, as per the independent claims.

Elaz also fails to disclose or suggest a modular external defibrillator system that includes a portable base, as recited by amended independent claims 1, 7, and 22. Elaz describes a base unit as follows:

Base units may be placed at appropriate locations in the hospital. They are permanently connected to the hospital network and receive power from the power mains.<sup>7</sup>

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<sup>1</sup> Elaz at Abstract.

<sup>2</sup> See *id.* at paragraph [0032], [0033].

<sup>3</sup> See *id.* at FIG. 3, paragraph [0034].

<sup>4</sup> See Office Action dated April 29, 2010, at page 2.

<sup>5</sup> See *id.*

<sup>6</sup> See Elaz at paragraph [0033].

<sup>7</sup> See *id.* at paragraph [0005] (emphasis added).

As seen above, a base unit according to the Elaz disclosure is a permanently affixed unit. As such, Elaz neither discloses nor suggest a base unit that is portable, as required by the amended independent claims.

Accordingly, even Elaz could be used in a rejection under 35 U.S.C. § 102(e), Elaz fails to disclose each and every feature of independent claims 1, 7, and 22.

Claims 3–6, 8–10, 24, 26, and 27 depend from independent claims 1, 7, or 22 and are therefore patentable over Elaz for at least the reasons given above with respect to the independent claims as well as upon additional patentable features and elements claimed in dependent claims 3–6, 8–10, 24, 26, and 27 but not explicitly discussed herein.

### ***Rejection in view of Gehab***

Amended independent claims 1 and 7 are directed toward a modular external defibrillator system that includes, among other elements, a portable base containing a defibrillator, and a patient monitoring pod. Gehab fails to disclose at least these features.

In support of the rejection of previously-presented claims 1 and 7, the Office Action characterized a portable monitor of Gehab as a patient monitoring pod and a docking station of Gehab as a base.<sup>8</sup> The Office Action then cited col. 6, lines 9–12 of Gehab for the proposition that the docking station of Gehab facilitates treatment through data sharing between the monitor and a connected defibrillator unit.<sup>9</sup> On this basis, the Office Action concluded that Gehab discloses each and every feature of previously-presented claims 1 and 7. Applicant respectfully disagrees for several of reasons.

First, the portable monitor of Gehab cannot reasonably be characterized as a patient monitoring pod required by independent claims 1 and 7. According to Gehab, a portable monitor is self-contained unit that includes processing electronics to process, display, and store patient data during transport.<sup>10</sup> Gehab further describes that the portable monitor acquires various physiological data signals from separate data acquisition pods.<sup>11</sup> However, Gehab provides no suggestion that a portable monitor can itself connect to a patient. Indeed, such a feature would not make sense based on the functionality of a typical portable monitor, or, more importantly, the

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<sup>8</sup> See Office Action dated April 29, 2010, at page 3.

<sup>9</sup> See *id.*

<sup>10</sup> See Gehab at col. 4, ll. 12–15.

<sup>11</sup> See *id.* at col. 4, ll. 39–4.

portable monitor disclosed by Gehab. On the other hand, independent claims 1 and 7 recite a monitoring pod configured to connect to a patient via lead cables. Because the portable monitor of Gehab does not include this feature, the portable monitor of Gehab cannot reasonably be characterized as the patient monitoring pod of claims 1 and 7.

Second, the docking station of Gehab cannot reasonably be characterized as the base required by claims 1 and 7. In claims 1 and 7, a base contains a defibrillator. By contrast, the docking station of Gehab does not contain a defibrillator. The entire Gehab reference makes only one single reference to a defibrillator in col. 6, lines 9–12, which the Office Action cited to and which are reproduced below.

Docking station 111 may also receive from portable monitor 102 a synchronization signal which may be used to trigger a defibrillator. This signal may then output from the [power supply and network] PSN 240.

The above-quoted passage notes that a docking station may receive a signal that may in turn be used to trigger a defibrillator. This passage does not remotely suggest that the docking station of Gehab contains a defibrillator. Rather, the passage indicates that the docking station and the defibrillator are two separate units. Indeed, the Office Action's characterization of Gehab, a characterization Applicant does not concede, asserted that the docking station of Gehab "facilitates treatment through data sharing between the monitor and the connected defibrillator," thus acknowledging that a monitor, defibrillator, and docking station are three separate units in Gehab. Accordingly, because the docking station of Gehab does not contain a defibrillator, the docking station of Gehab cannot reasonably be characterized as a base per independent claims 1 and 7.

Third, the docking station of Gehab is not portable and therefore does not disclose or suggest a portable base, as recited by claims 1 and 7. According to Gehab, a docking station includes three modular components: a monitor platform, a peripheral docking station platform, and a power supply and network box (PSN).<sup>12</sup> Gehab notes, however, that because a docking station platform may be mounted to a moveable bed or IV pole, it is desirable to provide a fixed position wallbox (i.e., the PSN) for coupling the docking station with power, devices, and networks.<sup>13</sup> Specifically, Gehab states that a PSN mounted on a wall is suitable for this

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<sup>12</sup> See *id.* at col. 3, ll. 15–13, 58–61.

<sup>13</sup> See *id.* at col. 5, ll. 34–43.

purpose.<sup>14</sup> Thus, Gehab does not disclose or suggest a portable base as recited by independent claims 1 and 7, but rather a docking station that is fixedly mounted to a wall and therefore not portable.

By failing to disclose either a base or a monitoring pod as required by independent claims 1 and 7, Gehab fails to disclose each and every feature of independent claims 1 and 7. Consequently, Gehab does not anticipate independent claims 1 and 7 under 35 U.S.C. § 102(b). Reconsideration and withdrawal of the rejections are therefore requested.

Claims 5 and 9 depend from independent claims 1 and 7, respectively, and are therefore patentable over Gehab for at least the reasons given above with respect to independent claims 1 and 7, as well as upon additional patentable features and elements claimed in dependent claims 5 and 9 but not explicitly discussed herein.

#### **Claim Rejection Under 35 U.S.C. § 103**

In the Final Office Action, the Examiner rejected claim(s) 3, 8, and 27 under 35 U.S.C. § 103(a) as being obvious over Elaz. Applicant respectfully disagrees.

As outlined above with respect to the 35 U.S.C. § 102(e) rejections based on the Elaz, the portion of Elaz relied upon in the Office Action are disqualified based on the relative priority dates of the present claims and the Elaz reference. Consequently, for at least this reason, the 35 U.S.C. § 103(a) rejections based on the Elaz are unwarranted.

Moreover, even assuming that the Elaz reference could be considered applicable under 35 U.S.C. § 103(a), Applicant respectfully traverses the rejection for failing to comply with the legal requirements for establishing a *prima facie* case of obviousness.

In support of the rejection of claims 3, 8, and 27 under 35 U.S.C. § 103(a), the Office Action asserted that the features of claims 3, 8, and 27 are inherently disclosed by Elaz or alternatively obvious in view of Elaz.<sup>15</sup> However, with respect to claims 3 and 8, the Office Action did not identify any apparent reason why a person of ordinary skill in the art would have modified Elaz to include features recited by claims 3 and 8. In effect, the Office Action asserted that the features of claims 3 and 8 are obvious simply because they are obvious.

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<sup>14</sup> See *id.*

<sup>15</sup> See Office Action dated April 29, 2010, at page 4.

Rejections based on obviousness under 35 U.S.C. § 103(a) cannot be sustained by such conclusory statements.<sup>16</sup> Instead, a detailed factual analysis is required that involves, *inter alia*, both ascertaining the scope and content of the prior art and ascertaining the differences between the prior art and the claims at issue.<sup>17</sup> In this case, the record is incomplete with regard to the differences between the prior art and the claims at issue, and the Office Action has provided no reason why a person of ordinary skill in the art would have modified Elaz to arrive at the features of claims 3, and 8. Therefore, the record is insufficient to support to the legal conclusion of obviousness.

Moreover, with respect to claim 27, Applicant respectfully traverses the assertion of “well known” in the art taken by the Examiner in the Office Action and submits that the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known, and, accordingly, the assertion of knowledge in the art is inappropriate without citing a prior art reference.<sup>18</sup> Indeed, neither Elaz nor any other reference of record, whether taken alone or in combination, discloses or suggests the features of independent claim 27. Applicant submits that such features are not unpatentable in view of the reference of record.

#### **New Claims:**

Applicant has added claims 32 and 33 to the pending application. Claims 32 and 33 each depend from independent claim 1. Accordingly, claims 32 and 33 are patentable for at least the reasons outlined above with respect to independent claim 1, as well as upon additional patentable features and elements claimed in the new dependent claims.

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<sup>16</sup> See *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. at \_\_\_, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006))

<sup>17</sup> See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966)

<sup>18</sup> See MPEP 2144.03.

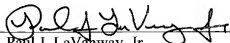
### CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims.

In view of the fundamental differences identified above, Applicant reserves further comment concerning the additional features set forth in the claims. However, Applicant does not acquiesce in the propriety of the Office Action's application or interpretation of the references with respect to the claims, and reserves the right to present additional arguments in any further prosecution of this application.

Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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